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09-22-03

OP 1632  
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# Clark & Elbing LLP

September 19, 2003

**BY COURIER**

Mr. Scott D. Priebe  
Primary Examiner Art Unit 1632  
Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

Re: Serial No.: 08/790,043  
Office Action

Dear Mr. Priebe:

Enclosed please find an Office Action relating to the above-referenced Serial Number. Since this case does not belong to a client of Clark & Elbing LLP (Customer No. 21559), we would appreciate if you would forward this document to the appropriate attorneys.

If you have any questions or comments, please feel free to contact me at your convenience.

Sincerely,

*Mishel M. Horta*

Mishel M. Horta  
Practice Systems Specialist

Enclosure

cc: Paul T. Clark, Esq.



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SEP 26 2003

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/790,043	01/28/1997	DAVID PAYNE	GM50005	

21559 7590 09/11/2003

CLARK & ELBING LLP  
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BOSTON, MA 02110

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SEP 15 2003

CLARK & ELBING LLP

EXAMINER

PRIEBE, SCOTT DAVID

ART UNIT

PAPER NUMBER

1632

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



## Office Action Summary

Application No.	PAYNE ET AL.
Examiner	Art Unit Scott D. Priebe

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.  
Period for Reply

SEP 26 2003

TECH CENTER 1600/2900

### A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 49-60 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 49-60 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 January 1997 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ . | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

Prosecution is hereby re-opened. The indication of allowability of claims 49-60 set forth in the Office action of 1/19/99 is withdrawn in view of the new rejections set forth below. Applicant is reminded that claims 49, 52, 56 and 57 were amended and claim 60 added by Examiner's amendment in the Office action of 1/19/99.

### *Claim Objections*

Claims 49 and 57 are objected to because of the following informalities: In claim 49, -- encodes a polypeptide which -- should be inserted before "differs" in line 7; "encodes ... which either a) ... or b) ..." would not include the last alternative. In claim 57, line 1, "the codes" should be -- that codes --. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 57-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Kunsch et al.

US 6,593,114 (which claims priority through US application 08/781,986, filed 1/3/97, to US provisional application filed 1/5/96).

Kunsch et al. discloses a polynucleotide comprising SEQ ID NO : 772. Nucleotides 24-704 of SEQ ID NO: 772 corresponds to nucleotides 1-678 of instant SEQ ID NO: 1. Col. 103-104 indicates that SEQ ID NO: 772 contains an open reading frame from nucleotides 1-677, which corresponds to nucleotides 1-652 of instant SEQ ID NO: 1. Over this region, SEQ ID NO: 772 differs from instant SEQ ID NO: 1 by four mispairs (at nucleotides 93, 468, 540, 571 of instant SEQ ID NO: 1) and two insertions of a single nucleotide (between nucleotides 627 and 628 and between nucleotides 650 and 651 of instant SEQ ID NO: 1). The first mispair is an A or C vs. A in SEQ ID NO: 1. This mispair occurs in the codon for amino acid 31 of instant SEQ ID NO: 2, and would encode either the same amino acid or a different amino acid as in SEQ ID NO: 2. The second and third mispairs do not change the amino acid encoded by SEQ ID NO: 2. The fourth mispair would result in coding for a different amino acid (amino acid 191 of SEQ ID NO: 2). The insertions cause a shift in reading frame after the codon for amino acid 209 of SEQ ID NO: 2. Consequently, SEQ ID NO: 772 would encode amino acids 1-190 and 192-209, or 1-30, 32-190, and 192-209 of SEQ ID NO: 2, depending on the choice of A or C, respectively, at the first mispair; and thus meets the limitation as a nucleic acid comprising a polynucleotide encoding a fragment of SEQ ID NO 2 comprising many of the regions recited in claim 57.

Kunsch also discloses vectors comprising SEQ ID NO: 772, and host cells comprising the vectors (col. 5-6, 15-19, for example).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

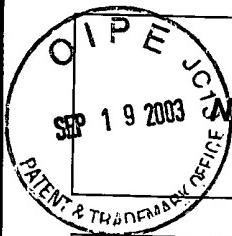
Claims 49-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,432,670. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scopes of these two sets of claims differ only slightly, with the instant claims embracing the subject matter claimed in the patent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott D. Priebe whose telephone number is (703) 308-7310. The examiner can normally be reached on M-F, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds can be reached on 703 305-4051. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Scott D. Priebe  
Primary Examiner  
Art Unit 1632



## Notice of References Cited

Application/Control No.  
08/790,043

Applicant(s)/Patent Under  
Reexamination  
PAYNE, AL

Examiner  
Scott D. Priebe

Art Unit  
1632

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SEP 26 2003  
Page 1 of 1

### U.S. PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	TECH CENTER 1600/2900	Classification 435/69.1
A	US-6,432,670 B1	08-2002	Payne et al.		
B	US-6,593,114 B1	07-2003	Kunsch et al.		435/91.41
C	US-				
D	US-				
E	US-				
F	US-				
G	US-				
H	US-				
I	US-				
J	US-				
K	US-				
L	US-				
M	US-				

### FOREIGN PATENT DOCUMENTS

*	Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
N					
O					
P					
Q					
R					
S					
T					

### NON-PATENT DOCUMENTS

*	Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)	
U		
V		
W		
X		

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.